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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,537	03/12/2002	Udo Skerdi	P-1105	4019

7590 12/12/2003

Scott R Cox  
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400 West Market Street Suite 2200  
Louisville, KY 40202

EXAMINER

MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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12

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Commissioner for Patents

See next pages.

• Art Unit: 3641

1. The reply filed on August 20, 2003 is not fully responsive to the prior Office Action for the reasons set forth in the following paragraphs. Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a), as to the shortened statutory time period that began on July 1, 2003.

The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

2. In Paper No. 10, applicants were required to take certain actions. Applicants did set forth the first publication date of their invention. Applicants submitted what may be a new translation of the specification. Further, applicants included a new listing of claims, in accordance with the recent requirements for amendments. However, applicants failed to comply on the question and issues on the specification, as detailed below.

As to the specification, applicant "requests that the specification that is reviewed by the USPTO be the official translation of the PCT document, WO 00/73236." Applicant then submits "by the use of this unamended specification, it is unnecessary to respond to the that were raised concerning the hand written amendments to the specification that was filed with the USPTO." This does not resolve the question of the correctness or new matter in the specification. This does not settle the question of whether the translation is a true and correct translation of the German language original document. It does not settle the issue of what, if anything in the English

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(American) language, differs from the original German in meaning, whereby the issue of the benefit of the WO parent and thus the German priority are warranted, in view of the requirement of statute requirement that the instant invention be disclosed as required by the first paragraph of 35 USC 112, to qualify for the benefit of the priority, e.g., date.

Applicant's request above that "the specification that is reviewed by the USPTO be the official translation" illustrates the problem. An examiner considers or reviews all the submitted specifications in the course of examination. Applicant does not state that the original specification without corrections (that was accepted) is identical to the instant translation. In other words, applicants have not stated whether the instant attachment "B" is identical to Paper No. 9, attachment "C" (submitted April 21, 2003) and to the originally accepted specification without interlineations. It is noted that there are page breaks that differ, and a difference in the font on page 3 of the originally accepted specification from the instant translation, at the part about the preferred amounts of silicate, between the instant attachment "B" and the originally accepted translation. However, the translation certificate appears to be a photocopy of the originally submitted translation, which original included the previously noted interlineations, notwithstanding that the new document [attachment "(B)"] is not a photocopy of the originally accepted specification as set forth above. Applicants have refused to comply with the requirement by the examiner to explain the interlineations. The interlineations suggest an incorrect translation, notwithstanding the belief of the translator that the translation is true and correct. The explanation would be considered during examination, but an explanation not proffered cannot be considered. Applicant is reminded of the duty of candor. Note also 37 CFR 1.122(b), and CFR 1.135:

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§ 1.135 Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

See also MPEP 1304.03 [in pertinent part, emphasis added]:

The practice set forth in 37 CFR 1.135(c) does not apply where there has been a deliberate omission of some necessary part of a complete reply; rather, 37 CFR 1.135(c) is applicable only when the missing matter or lack of compliance is considered by the examiner as being “inadvertently omitted.” For example, if an election of species has been required and applicant does not make an election because he or she believes the requirement to be improper, the amendment on its face is not a “bona fide attempt to advance the application to final action” (37 CFR 1.135(c)), and the examiner is without authority to postpone decision as to abandonment. **Likewise, once an inadvertent omission is brought to the attention of the applicant, the question of inadvertence no longer exists.** Therefore, a second Office action giving another new (1 month) time period to supply the omission would not be appropriate under 37 CFR 1.135(c).

The conclusion of applicant, that no explanation is required, is not a proper response. Applicant has not submitted any basis or support for their position that their reply is appropriate or proper reply to the requirement of the examiner. The instant reply might also be construed to request that instant attachment “B” be accepted as a substitute specification. This is defective as contrary to the prior requirement for compliance with the rules. See instant 37 CFR 1.121(a) [emphasis added]:

§ 1.121 Manner of making amendments in application.

(a) Amendments in applications, other than reissue applications.  
Amendments in applications, other than reissue applications, are made by filing a paper, **in compliance with § 1.52,** directing that specified amendments be made.

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In 37 CFR 1.52, note part “(b)” thereof, as follows {emphasis added}:

(b) The application (specification, including the claims, drawings, and oath or declaration) or reexamination proceeding and any amendments or corrections to the application or reexamination proceeding .

(1) The application or proceeding and any amendments or corrections to the application (including any translation submitted pursuant to paragraph (d) of this section) or proceeding, except as provided for in § 1.69 and paragraph (d) of this section, must:

(i) Comply with the requirements of paragraph (a) of this section; and

(ii) Be in the English language or be accompanied by a translation of the application and a translation of any corrections or amendments into the English language together with a statement that the translation is accurate.

(2) The specification (including the abstract and claims) for other than reissue applications and reexamination proceedings, and any amendments for applications (including reissue applications) and reexamination proceedings to the specification, except as provided for in §§ 1.821 through 1.825, must have:

(i) Lines that are 1 1/2 or double spaced;

The instant translation, attachment “(B)”, is single spaced and so would be improper, and was previously objected to, Paper No. 7, page 7, numbered paragraph “11.”

3. The time period starting July 21, 2003 continues to run. Applicant is required to comply with the previous requirements and obtain such extension of time as may be required. Failure to comply will result in the application being held abandoned for failure to submit “such complete and proper reply as the condition of the application may require,” 37 CFR 1.135(b).

4. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198.

If there is no answer, or for any inquiry of a general nature or relating to application status, please call the Group receptionist at (703) 308-1113.

Miller/em  
December 9, 2003



EDWARD A. MILLER  
PRIMARY EXAMINER